

Date: Sept 22, 2004

I hereby certify that this document is being filed by personal delivery to the Customer Service Window, Crystal Plaza 2, 2011 South Clark Place, Arlington Virginia, of the United States Patent & Trademark Office on the date indicated above.

By: [Signature] Reg No 32,858
(Attorney Signature and Reg. No.)



Patent
Attorney's Docket No. 10991471-12

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	
Steven W. Trovinger)	Group Art Unit: 3722
Application No.: 10/698,499)	Examiner: Unassigned
Filed: October 30, 2003)	Confirmation No.: 9588
For: METHOD AND APPARATUS FOR)	
MAKING BOOKLETS)	

**PETITION UNDER 37 C.F.R. § 1.78(a)(3) TO ACCEPT AN UNINTENTIONALLY
DELAYED REFERENCE UNDER 35 U.S.C. § 120 AND/OR § 365**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with 37 C.F.R. § 1.78(a)(3), Applicant hereby requests the U.S. Patent and Trademark Office to accept the unintentionally delayed reference to the claim under 35 U.S.C. § 120 and/or § 365 in this application.

In accordance with 37 C.F.R. § 1.78(a)(3)(i), the reference required by 35 U.S.C. § 120 and 37 C.F.R. § 1.78(a)(2) is concurrently submitted in the accompanying Second Preliminary Amendment dated September 22, 2004.

In accordance with 37 C.F.R. § 1.78(a)(3)(ii), a fee of \$1,330.00 is required under 37 C.F.R. § 1.17(t). The Director is hereby authorized to charge Deposit Account No. 08-2025 for the fee due.

09/23/2004 HWDJG1 00000003 082025 10698499
01 FC:1454 1330.00 DA

On information and belief, the entire delay between the date the reference to the claim under 35 U.S.C. § 120 and/or § 365 was due under 37 C.F.R.

§ 1.78(a)(2)(ii) and the date the reference required by 37 C.F.R. § 1.78(a)(2) is submitted in this application was unintentional. The following facts are presented in support of this Petition.

1. The present application is a divisional application of parent Application Serial No. 09/831,768. The parent Application Serial No. 09/831,768, was filed as a § 371 national stage application of International Application No. PCT/US99/23078. The international application is also a Continuation-in-Part Application of U.S. Application No. 09/162,844, filed on September 29, 1998.
2. The specification in parent Application Serial No. 09/831,768 did NOT contain a reference to the prior filed applications, because no such reference was required. The International Application was filed on September 29, 1999, and was therefore exempted per 37 C.F.R. § 1.78(a)(2)(ii)(C) from the requirements of 37 C.F.R. § 1.78 when the International Application was nationalized.
3. The present divisional application made a claim for priority to parent Application Serial No. 09/831,768, in the transmittal and to the International Application No. PCT/US99/23078 and the Continuation-in-Part Application No., 09/162,844, in the originally filed Declaration (see Attachment A). The present divisional application was filed on October 30, 2003, with a photocopy of the original specification of Application Serial No. 09/831,768.
4. Because the original specification of parent Application No. 09/831,768 did not contain a cross-reference to the International Application or CIP Application, the photocopy of the parent used to file the present divisional application did not contain a cross-reference to the International Application.
5. The present application was amended at the time of filing to include a cross-reference to Application Serial No. 09/831,768 (see Preliminary Amendment Attachment B). However, a cross-reference to the International Application and CIP Application was unintentionally not included in the Preliminary Amendment.
6. Upon becoming aware of the failure to timely meet the requirements of 37 C.F.R. § 1.78, we promptly prepared and submitted this Petition to make the cross-reference to the International Application and CIP Parent Application on page 1 of the specification in the present divisional application.

Accordingly, because all requirements for a proper Petition Under 37 C.F.R. § 1.78 have been satisfied, granting of this Petition to recognize Applicant's claim for priority to the International Application is requested. Upon granting of the Petition, it is respectfully requested that the accompanying Second Preliminary Amendment (Attachment C) be entered in this application.

Date: Sept 22, 2004



Patrick C. Keane



ATTACHMENT A TO PETITION UNDER
37 C.F.R. § 1.78 (a)(3) IN
U.S. PATENT
APPLICATION S/N 10/698,499

Contents: Copy of Original Declaration in S/N 09/831,768

DECLARATION AND POWER OF ATTORNEY
FOR PATENT APPLICATION

ATTORNEY DOCKET NO. 10991471-1

SEP 22 2004

As a below named inventor, I hereby declare that:

My residence/post office address and citizenship are as stated below next to my name:

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

Method And Apparatus For Making Booklets

the specification of which is attached hereto unless the following box is checked:

(X) was filed on Sep 29, 1999 as US Application Serial No. or PCT International Application Number US99/23078 and was amended on (if applicable).

I hereby state that I have reviewed and understood the contents of the above identified specification, including the claims, as amended by any amendment(s) referred to above. I acknowledge the duty to disclose all information which is material to patentability as defined in 37 CFR 1.56.

Foreign Application(s) and/or Claim of Foreign Priority

I hereby claim foreign priority benefits under Title 35, United States Code, Section 119 of any foreign application(s) for patent or inventor(s) certificate listed below and have also identified below any foreign application for patent or inventor(s) certificate having a filing date before that of the application on which priority is claimed:

COUNTRY	APPLICATION NUMBER	DATE FILED	PRIORITY CLAIMED UNDER 35 U.S.C. 119
PCT	PCT/US99/23078	09/29/99 G	YES: <input checked="" type="checkbox"/> NO: <input type="checkbox"/>
			YES: <input type="checkbox"/> NO: <input type="checkbox"/>

Provisional Application

I hereby claim the benefit under Title 35, United States Code, Section 119(e) of any United States provisional application(s) listed below:

APPLICATION SERIAL NUMBER	FILING DATE

U. S. Priority Claim

I hereby claim the benefit under Title 35, United States Code, Section 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, Section 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, Section 1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

APPLICATION SERIAL NUMBER	FILING DATE	STATUS (patented/pending/abandoned)
09/162844	09/29/1998	Pending

POWER OF ATTORNEY:

As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith:

Customer Number: 022879

Place Customer
Number Bar Code
Label here.

Send Correspondence to:
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80528-9599

Direct Telephone Calls To:

Edward Maker II
(650) 857-6143

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full Name of Inventor: Steven W Trovinger

Citizenship: US

Residence: 1099 Parma Way Los Altos, CA 94204

Post Office Address: 1501 Page Mill Road Palo Alto, CA 94304

Inventor's Signature

Date

11/23/99

DECLARATION AND POWER OF ATTORNEY
FOR PATENT APPLICATION (continued)

Full Name of # 2 Joint Inventor: Ross R Allen Citizenship: US
Residence: 408 Mainline Dr Belmont CA 94002
Post Office Address: 1501 Page Mill Road Palo Alto, CA 94304
Inventor's Signature: [Signature] Date: 12/3/99

Full Name of # 3 Joint Inventor: Erik G Vaaler Citizenship: US
Residence: 707 Leahy Street # 216-B Redwood City, CA 94061
Post Office Address: 1501 Page Mill Road Palo Alto, CA 94304
Inventor's Signature: [Signature] Date: 11/24/99

Full Name of # 4 Joint Inventor: _____ Citizenship: _____
Residence: _____
Post Office Address: _____
Inventor's Signature: _____ Date: _____

Full Name of # 5 Joint Inventor: _____ Citizenship: _____
Residence: _____
Post Office Address: _____
Inventor's Signature: _____ Date: _____

Full Name of # 6 Joint Inventor: _____ Citizenship: _____
Residence: _____
Post Office Address: _____
Inventor's Signature: _____ Date: _____

Full Name of # 7 Joint Inventor: _____ Citizenship: _____
Residence: _____
Post Office Address: _____
Inventor's Signature: _____ Date: _____

Full Name of # 8 Joint Inventor: _____ Citizenship: _____
Residence: _____
Post Office Address: _____
Inventor's Signature: _____ Date: _____



ATTACHMENT B TO PETITION UNDER
37 C.F.R. § 1.78 (a)(3) IN
U.S. PATENT
APPLICATION S/N 10/698,499

Contents: Copy of Preliminary Amendment filed in S/N 10/698,499 on October 30, 2003, including copy of transmittal and Express Mail Receipt



IN THE
U.S. PATENT AND TRADEMARK OFFICE

Anticipated Classification of this application:

Class _____ Subclass _____

Prior application:

Examiner: Patrick H. Mackey

Art Unit: 3651

Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

I hereby certify that this is being deposited with the United States Postal Service "Express Mail, Post Office to Addressee" service under 37 CFR 1.10 on Oct 30 2003 and is addressed to the Commissioner for Patents, Alexandria, VA 22313-1450

"Express Mail" label no. EV207630911

Typed Name: Dee Timmons

Signature: Dee Timmons

REQUEST FOR A CONTINUING APPLICATION UNDER 37 CFR 1.53(b)

Sir:

This is a request for filing a continuing application under 37 CFR 1.53(b) a

() continuation application of:

(X) divisional application of:

Pending Prior Application

Application No. 09/831,768 filed May 14, 2001

Title METHOD AND APPARATUS FOR MAKING BOOKLETS

Name of applicant(s) Steven W. Trovinger

Copy of Application

(X) Enclosed is a copy of the prior application, including the drawings.

() Enclosed is a new specification, including new drawings.

Oath or Declaration

(X) Enclosed is a copy of the prior Declaration (37 CFR 1.63(d)).

() Enclosed is a newly executed Declaration (original or copy).

Foreign Priority - 35 USC 119

() Foreign priority under 35 U.S.C. 119 has been claimed in prior Application No. _____
filed on _____ in _____

() The certified copy has been filed in prior Application No. _____
filed _____

() A separate paper claiming direct priority to a foreign application is enclosed herewith. A certified copy of the foreign application will be provided in due course.

Relate Back - 35 USC 120

Cross Reference To Related Application(s):

This is a () continuation (X) divisional

of copending application number 09/831,768 filed on May 14, 2001

which is hereby incorporated by reference herein.

Inventorship Statement

- () Delete the following named individuals as inventors in this application in accordance with 37 CFR 1.53(b) as a result of a change in the claimed subject matter:

Appointment of Associate Attorney

- () Recognize as Associate Attorney or Agent _____
Registration No. _____
() authorization is hereby granted by signature below of the Attorney or Agent of record
() the Associate Attorney or Agent may not have the authority to appoint other Attorneys or Agents

Communications

- (X) Address all future communications to: Direct telephone calls to:

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
Fort Collins, Colorado 80527-2400

Susan E. Heminger
(650) 236-2738

Other Amendments

- (X) Enter the enclosed Preliminary Amendment. The filing fee is calculated on the basis of the amended claims.

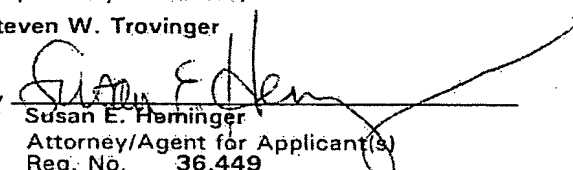
Fee Calculation

- (X) The filing fee is calculated below for (X) Utility () Design

CLAIMS AS FILED BY OTHER THAN A SMALL ENTITY				
(1) FOR	(2) NUMBER FILED	(3) NUMBER EXTRA	(4) RATE	(5) TOTALS
TOTAL CLAIMS	15 — 20	0	X \$18	\$ 0
INDEPENDENT CLAIMS	2 — 3	0	X \$86	\$ 0
ANY MULTIPLE DEPENDENT CLAIMS	0		\$290	\$ 0
BASIC FEE: Design (\$340.00); Utility (\$770.00)				\$ 770
TOTAL FILING FEE				\$ 770
TOTAL CHARGES TO DEPOSIT ACCOUNT				\$ 770

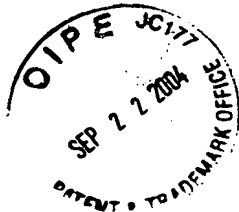
Charge \$ 770 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

Respectfully submitted,
Steven W. Trovinger

By 
Susan E. Heminger
Attorney/Agent for Applicant(s)
Reg. No. 36,449

Date: Oct. 30, 2003

Telephone No.: (650) 236-2738



Dear Sir:

Please acknowledge receipt of the following document(s)
RE: U.S. Patent Application PD No. 10991471-12 Atty: SEH

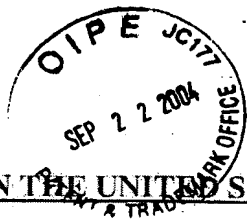
Inventor: Steven W. Trovinger

Title: METHOD AND APPARATUS FOR MAKING BOOKLETS

Continuation Application of S/N 09/831,768 dated May 14, 2001

☒ Transmittal Letter for request for continuing application
under 37 C.F.R. 1.53(b) Divisional (in duplicate)
53 Pages of Specification, Claims and Abstract
☒ 22 Sheets of drawings
☒ Declaration and Power of Attorney
☒ Certificate of Express Mail dated October 30, 2003
Label No. EV 207630911 US

EV207630911US



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Steven W. Trovinger
Serial No.: 09/831,768

Group Art Unit: not available
Examiner: not available

Filed: May 14, 2001

Title: Method and Apparatus for Making Booklets

Atty Docket: 10991471-9

PRELIMINARY AMENDMENT

Hon. Commissioner for Patents
Washington, D.C. 20231

Sir:

Please consider the following preliminary amendment in connection with the divisional application of the above-noted application filed herewith.

Amendments to the Specification begin on page 2 of this paper.

Amendments to the Claims are reflected in the listing of claims which begins on page 3 of this paper.

Remarks/Arguments begin on page 6 of this paper.

Amendments to the Specification

Page 1 of the application, after the Title please insert the following paragraph:

CROSS-REFERENCES TO RELATED APPLICATIONS

This application is a divisional of prior Application No. 09/831,768 filed May 14, 2001.

Amendments to the Claims:

This listing of claims will replace all prior versions, and listings, of claims in the present application:

Listing of Claims:

Claims 1-5 (cancelled)

Claim 6 (original) Apparatus for folding sheets of printing media, comprising:

- a) a V-shaped fold roller;
- b) an elongate fold blade;
- c) means for positioning the sheets, sheet-by-sheet, on the fold blade and connected thereto; and
- d) means for translating the fold roller with respect to the fold blade, thereby folding the sheets, sheet-by-sheet.

Claim 7 (original) The apparatus of claim 6 further including an elongate flap connected to the fold roller that initiates the fold in each sheet, sheet-by-sheet.

Claim 8 (original) The apparatus of claim 7 further including a second elongate flap connected to the fold roller, said flaps initiate the fold in each sheet, sheet-by-sheet, and said flaps are outward opening away from the fold blade.

Claim 9 (original) The apparatus of claim 8 further including a hinge for movably mounting said flaps and for accommodating sheets of differing thicknesses.

Claim 10 (original) The apparatus of claim 6 further including a pinch roller that captures the sheets on the fold blade, sheet-by-sheet, prior to folding.

Claim 11 (original) The apparatus of claim 6 wherein the fold roller has a cylindrical outer wall and the cylindrical wall has a V- shaped opening therein that accepts both the sheet and the fold blade during folding.

Claim 12 (original) The apparatus of claim 6 wherein the fold roller has two complementary disks spring loaded together on a common axle and each disk has a tapered, inward facing peripheral edge, thereby accommodating sheets of various thicknesses.

Claim 13 (original) The apparatus of claim 6 further including means, connected to the fold blade, for unloading the sheets, sheet-by-sheet, from the apparatus after folding.

Claims 14-41 (cancelled)

Claim 42 (original) A method for folding sheets of printing media, comprising the steps of:

- a) positioning the sheets, sheet-by-sheet, in a media folder;
- b) folding the sheets, sheet-by-sheet, in the media folder; and
- c) unloading the folded sheets, sheet-by-sheet, from the folder.

Claim 43 (original) The method of claim 42 further including the step of folding the sheets more than once so that each sheet has a plurality of folds.

Claim 44 (original) The method of claim 42 further including the step of capturing the sheets, sheet-by-sheet, prior to the step of folding.

Claim 45 (cancelled)

Claim 46 (original) The method of claim 42 further including the step of alternately folding the sheets, sheet-by-sheet, so that each sheet has a Z-shape after being folded.

Claim 47 (original) The method of claim 42 further including the step of multiply folding the sheets, sheet-by-sheet, so that selected sheets have a U-shape after being folded.

Claim 48 (original) The method of claim 42 further including the step of putting a slack loop in each sheet in the media folder prior to the step of folding.

Claim 49 (original) The method of claim 42 wherein the step of folding includes the step of translating a fold roller back and forth across a fold blade over which each sheet is positioned.

Claims 50-62 (cancelled)

REMARKS

Applicant respectfully requests consideration of the above preliminary amendment.

Amendments to the Specification

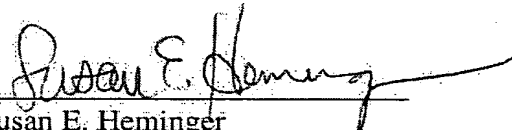
The present application is a divisional of an original parent application. A section entitled "CROSS-REFERENCES TO RELATED APPLICATIONS" has been added after the title indicating that the present application is a divisional of prior Application No. 09/831,768 filed May 14, 2001.

Amendments

Claims 1-5, 14-41, 45, and 50-62 are cancelled and Claims 6-13, 42-44, and 46-49 are remaining.

Respectfully submitted,

Steven W. Trovinger

By 
Susan E. Heminger
Reg. No. 36,449

October 27, 2003
Hewlett-Packard Company
Legal Department IPA
P.O. Box 272400
Fort Collins, CO 80527-2400

ATTACHMENT C TO PETITION UNDER 37 C.F.R.
§ 1.78(A)(3)

IN

US. PATENT APPLICATION S/N 10/698,499

Contents: Currently Submitted Second Preliminary Amendment

AMENDMENTS TO THE SPECIFICATION:

Please replace the first paragraph after the title containing the cross-reference information with the following paragraph:

CROSS-REFERENCE TO RELATED APPLICATIONS

This application is a divisional of prior Application No. 09/831,768 filed May 14, 2001, which is a §371 National Stage Application of PCT International Application No. PCT/US99/23078 filed September 29, 1999, which International Application was published by the International Bureau in English on April 6, 2000, which is a Continuation-in-Part Application of U.S. Application No. 09/162,844, filed on September 29, 1998, now abandoned.

AMENDMENTS TO THE CLAIMS:

This listing of claims will replace all prior versions, and listings, of claims in the application:

LISTING OF CLAIMS:

Claims 1-5 (Canceled)

6. (Original) Apparatus for folding sheets of printing media, comprising:

- a) a V-shaped fold roller;
- b) an elongate fold blade;
- c) means for positioning the sheets, sheet-by-sheet, on the fold blade and connected thereto; and

- d) means for translating the fold roller with respect to the fold blade, thereby folding the sheets, sheet-by-sheet.

7. (Original) The apparatus of claim 6 further including an elongate flap connected to the fold roller than initiates the fold in each sheet, sheet-by-sheet.

8. (Original) The apparatus of claim 7 further including a second elongate flap connected to the fold roller, said flaps initiate the fold in each sheet, sheet-by-sheet, and said flaps are outward opening away from the fold blade.

9. (Original) The apparatus claim 8 further including a hinge for movably mounting said flaps and for accommodating sheets of differing thicknesses.

10. (Original) The apparatus of claim 6 further including a pinch roller that captures the sheets on the fold blade, sheet-by-sheet, prior to folding.

11. (Original) The apparatus of claim 6 wherein the fold roller has a cylindrical outer wall and the cylindrical wall has a V-shaped opening therein that accepts both the sheet and the fold blade during folding.

12. (Original) The apparatus of claim 6 wherein the fold roller has two complementary disks spring loaded together on a common axle and each disk has a tapered, inward facing peripheral edge, thereby accommodating sheets of various thicknesses.

13. (Original) The apparatus of claim 6 further including means, connected to the fold blade, for unloading the sheets, sheet-by-sheet, from the apparatus after folding.

Claims 14-41 (Canceled).

42. (Original) A method for folding sheets of printing media, comprising the steps of:

- a) positioning the sheets, sheet-by-sheet, in a media folder;
- b) folding the sheets, sheet-by-sheet, in the media folder; and
- c) unloading the folded sheets, sheet-by-sheet, from the folder.

43. (Original) The method of claim 42 further including the step of folding the sheets more than once so that each sheet has a plurality of folds.

44. (Original) The method of claim 42 further including the step of capturing the sheets, sheet-by-sheet, prior to the step of folding.

45. (Canceled)

46. (Original) The method of claim 42 further including the step of alternately folding the sheets, sheet-by-sheet, so that each sheet has a Z-shape after being folded.

47. (Original) The method of claim 42 further including the step of multiply folding the sheets, sheet-by-sheet, so that selected sheets have a U-shape after being folded.

48. (Original) The method of claim 42 further including the step of putting a slack loop in each sheet in the media folder prior to the step of folding.

49. (Original) The method of claim 42 wherein the step of folding includes the step of translating a fold roller back and forth across a fold blade over which each sheet is positioned.

Claims 50-62 (Canceled).

REMARKS

Entry of the foregoing is respectfully requested. Claims 6-13, 42-42 and 46-49 are pending.

CLAIM FOR BENEFIT OF EARLIER FILING DATE AND CROSS-REFERENCE TO RELATED APPLICATIONS

Enclosed herewith is a Petition Under 37 C.F.R. § 1.78(a)(3) to Accept an Unintentionally Delayed Reference to a Claim under 35 U.S.C. § 120 and/or § 365. The present amendment to the specification makes the cross-reference to related applications required under 37 C.F.R. § 1.78. It is respectfully requested upon granting of the Petition that this application be accorded the benefit of the earlier filing date, as provided under 35 U.S.C. §§ 363 and 365.

CONCLUSION

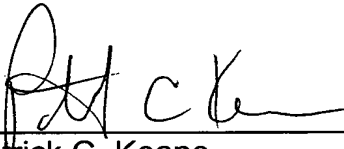
Examination and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues can be resolved over the telephone, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: September 22, 2004

By: _____



Patrick C. Keane

Registration No. 32,858

Hewlett Packard Company
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

(703) 836-6620